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10/685,455	10/16/2003	Paul Lapstun	NPA127US	5430

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AUSTRALIA

EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,455

Applicant(s)

LAPSTUN ET AL

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment received on 11/18/2004 is acknowledged and entered. The applicant amended claims 1 and 22. Currently claims 1-35 are pending for examination. The examiner also acknowledges the Terminal disclaimer received on 11/18/2004 to obviate a Provisional Double Patenting Rejection over Co-pending Application 09/608,022.

Response to Arguments

2.1. Applicant's arguments filed on 11/18/2004 (see Remarks, page 8) concerning Provisional Double Patenting Rejection of claims 1-35 over Co-pending Application 09/608,022. of claims 1-35 have been fully considered and are persuasive in view of the Terminal Disclaimer filed on 11/18/2004. Accordingly, the Provisional Double Patenting Rejection of claims 1-35 is withdrawn.

2.2. Applicant's arguments with respect to amended independent claims 1 and 22 have been considered but are moot in view of the new ground(s) of rejection necessitated due to the amendments.

2.3. In response to applicant's argument (See Remarks, page 8) that the reference Wolff uses gyroscopes or accelerometers in a pen-instrument and that his invention does not need them, it is noted that these features are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2.4. In response to the examiner's taking Official Notice in rejecting claims 16-17, 21, and 32-35, the applicant has neither traversed the facts and benefits of the Official Notice, taken by the

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examiner, adequately nor asked for a documentary evidence. Therefore, as per *MPEP-2144.03 [R-1] C Reliance on Common Knowledge in the Art or "Well Known" Prior Art* -, the common knowledge or well-known fact considered as Official Notice in the art statement is taken to be admitted prior art and the rejection of claims 16-17, 21, and 32-35 is maintained using the Official Notice.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3.1. Claims 1-15, 18-20, and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Patterson and further in view of Bennett et al. (US Patent 5,051,736), hereinafter referred to Bennett .

Regarding claim 1, Wolff discloses a method of enabling a buyer to submit a bid, the method including the steps of: providing the auction buyer with a printed paper form containing

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information relating to a bid transaction, the form including coded data indicative of at least one parameter of the bid transaction and of a plurality of reference points of the form; receiving, in a computer system, data from a sensing device regarding said at least one parameter and regarding movement of the sensing device relative to the form, the sensing device, when moved relative to the form, sensing the data regarding said at least one parameter using at least some of the coded data and generating the data regarding its own movement relative to the form; and interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter (See Wolf, at least Abstract and col.1, line 30-col.4, line 38. Quote:

" , users can readily create or manipulate paper documents while simultaneously making corresponding electronically-coded images of the same created or manipulated paper document. This is accomplished by means of a hand-held, pen-like instrument that can write on paper documents, simultaneously sense the writing, and interpret and enter the written markings in the electronically-coded document. Also, image sensing allows the system to identify the type of document being subjected to manually-written modifications.(a) a physical document page with a surface suitable to be written upon that can also contain pre-printed document information; (b) a pen-instrument for writing on the physical document surface, the pen-instrument having suitable transducers for sensing both the written data(c) a base unit for receiving the transducer data and converting the transducer data to binary digital information suitable for processing in the base unit CPU, or another computer, for document identification and for incorporating the written information with the pre-printed document information.Forms Processing: filling out of a prescribed form would automatically cause the generation of a corresponding electronic form, the paper version being kept, as needed, for legal or safety reasons. A significant cost reduction in computer data entry results.Document Editing: any paper document can be edited by crossing-out words, and by the use of typographic notation for other editing operations, or annotated, or sent elsewhere. The paper modifications immediately affect the electronic version so that the electronic version can serve as the true source document because any access of, or communications of, that document would reflect all edits or annotations. Document Retrieval: searching of electronic

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databases by writing or circling a few keywords, thumbnail descriptions, or by drawing pictures, which, when interpreted, provide the data location. ...Note Book: using the pen-instrument for writing notes on paper and for electronically retrieving notes previously written on paper and stored from a sequentially ordered (and/or an otherwise organized) electronic memory file..... Digitally coded information is printed on each page so that the pen-instrument can be used to read the pertinent digital code that identifies the page format and the segments of calendar time spanned by the CB page.FIG.1 shows a page 20 from a CB using a one day per page format. This version allows selectable information options to be printed for each day.....The graphical display can provide immediate feedback by use of an optional cathode ray tube (CRT) display. The feedback can be a simple recreation of the written message by using pen-instrument positional writing point pressure data or the interpreted written message from a cursive character recognition device using the same data. In the latter case, incorrectly recognized written data can be scratched-out or over-written.FIG. 2 is a flow diagram describing the basic operating mode of a particular CB. The operation begins at step 500 where it is assumed that a fixed format has been prescribed and its description is stored with the configuration information for that CB. Configuration data includes calendar type, chronology layout defining time intervals, segments, and writing spaces. Also, a user list is stored against which the bar-code I.D. can be checked for validity.At step 501, the computer checks if the pen-instrument is moving horizontally, indicating that a CB operation is about to be initiated by reading the bar-code located in area 13. If not, the system goes into a wait loop in which the pen-instrument motion is monitored. If the appropriate horizontal motion is detected, the process proceeds to step 502 in which the bar-code I.D. is read by scanning bar-code area 13 with the pen-instrument. If a valid bar code signal results, step 503 moves the process to step 505, otherwise the process goes to step 504 where an audible and/or visual alarm is set for informing the user that access is denied and the system returns to step 501. The bar-code can also be compared with a list of authorized codes and if a match exists the CB access request is validated and proceeds to step 505. At this juncture, the pen-instrument user may try to read the bar-code again or investigate the system for the cause of the misread bar-code data. ". Unquote. As disclosed above, the pre-printed coded form or CB page in Wolff represent a printed paper form as claimed in the applicant's invention.

Wolff does not expressly teach that the encoded data in the form contains information relating to bid transactions. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The providing, receiving and interpreting steps would be performed the same regardless of the *data contained in the pre-printed forms, that is if data is related to a calendar book, bid transaction, or any other data*. Thus, this *descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to contain any type of *data* in the pre-printed form and provide it to a variety type of users depending upon their intended uses, such as, a pre-printed form for maintaining appointments information, filling out any prescribed form, editing a form, as disclosed in Wolff or for other uses as well like using a pre printed form for bid transaction for auction buyer , etc. because such *data* does not *functionally* relate to the steps in the method claimed and because the subjective interpretation of the *data* does not patentably distinguish the claimed invention.

However, Patterson, in the analogous field of transferring orders, quotes and memos by using pen-type input devices, discloses the steps wherein electronic forms contain information relating to a bid transaction being provided to a user and the coded data being sensed includes at least one parameter relating to the bid transaction (See col. 13 line 20 – col. 15 line 55). The step where the user is an auction buyer is old and well-known in the art. It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole

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suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed.

Both Wolff and Patterson fail to teach that the coded data identifies a unique location of each of the reference points relative to the form. However, in the field of same endeavor, Bennett discloses identifying a unique location of each of the reference points relative to the form (see at least abstract, col.1, lines 6-12, "*The present invention relates to two dimensional data input devices typically used with computer systems in conjunction with a video display subsystem. More particularly, it relates to such devices for producing X-Y positional information which can be directly utilized to store or display the pattern of stylus movement on a suitable tablet or surface.*" and col.3, lines 38-60, "*The objects of the present invention are accomplished in general by a stylus and tablet X-Y data input system for producing digitized coordinate stylus location data for a video display system or the like. The pen includes an illumination and optical pick up means for sensing digitized X-Y coordinate data encoded in binary form and recorded on the tablet in such a fashion that the pen position upon the tablet is automatically determinable by illuminating a predetermined area of the tablet and reading the digitized X-Y coordinate data stored therein.*"). Both Wolff and Bennett are directed to allowing users to enter data in pre-printed paper forms such that entered data is stored in a computer and be used to display or for any other extended function. It would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wolff to incorporate the feature of identifying a unique location of each of the reference points relative to the form because it will help to provide extremely high resolution thereby making the system suitable for high quality graphical data input such as handwritten text, as explicitly suggested in Bennett (see at least col.3, lines 54-59, "*Utilizing the concepts of the present invention, up to 250,000 digitally encoded coordinate pairs may be encoded in the tablet surface per square inch which provides extremely high resolution thus making the system suitable for high quality graphical data input such as handwritten text and the like.*").

Regarding claims 2 and 3, Wolf/Patterson/Bennett discloses a method of enabling an auction buyer to submit a bid as applied to claim 1. Patterson further discloses that the parameter is an action parameter of the bid transaction, the method including effecting, in the computer system, an operation in respect of the action parameter including placing a bid (See at least Patterson col. 13 lines 20-32). It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids.

Regarding claim 4, Wolf/Patterson/Bennett discloses a method of enabling an auction buyer to submit a bid as applied to claim 1. Patterson further discloses, in which the parameter is an option parameter of the bid transaction, the method including identifying, in the computer system, that the buyer has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, as operation associated with the option parameter (See at least Patterson Figures 4, 8, 11 and col.12, line 20-col.15, line 55). It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids.

Regarding claim 5, Wolf/Patterson/Bennett discloses a method of claim 4 in which respectively, in which the option parameter is associated with placing a bid (See at least

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Patterson Figures 4, 8, 11 and col.13, line 20-col.15, line 55. It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids.

Regarding claims 6-7, Wolf/Patterson/Bennett discloses a method of claim 1, in which the parameter is a text parameter of the bid transaction, the method including identifying, in the computer system, that the auction buyer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter including converting, in the computer system, the handwritten text data to computer text (See at least Patterson Figures 4, 8, 11 and col.13, line 20-col.15, line 55). It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids.

Regarding claim 8, Wolf/Patterson/Bennett discloses a method claims 7, in which the text parameter is associated with at least one of a name of the buyer, item search text, and a bid amount (See at least Patterson Figures 4, 8, 11 and Column 13 line 20 - Column 15 line 55). It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the

disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids.

Regarding claims 9-10, Wolf/Patterson/Bennett discloses a method of claim 1 and Patterson further discloses that the parameter is an authorization parameter of the bid transaction , the method including identifying, in the computer system, that the auction buyer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying , in the computer system, that the signature is that of the buyer (See at least Patterson Figures 4, 8, 11 and Column 13 line 20 - Column 15 line 55). The verifying step is inherent in the disclosure of Patterson. It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids and authorizing them.

Regarding claim 11, Wolf/Patterson/Bennett discloses a method of claim 10, in which the authorization parameter is associated with authorization of placing a bid (See at least Patterson Figures 4, 8, 11 and Column 13 line 20 - Column 15 line 55). It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using

a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids and authorizing them.

Regarding claims 12-14, Wolf/Patterson/Bennett discloses a method of claim 1, in which the parameter is a picture parameter, an operation associated with the picture parameter, which in turn is associated with a picture of a listed item and that the form contains information relating to at least a listed item (See at least Wolff col.3, lines 15-20).

Regarding claim 15, Wolf/Patterson/Bennett discloses a method of claim 1 which includes printing the form on demand (inherent in the disclosure of Wolff).

Regarding claims 18 and 20, Wolf/Patterson/Bennett discloses that the method of claim 1 further includes distributing a plurality of the forms using a mixture of protocols (See at least Patterson col.19, lines 11-27 and col.23 lines 44-47) and including providing all required information relating to the bid transaction in the form to eliminate the need for a separate display device (See at least Patterson Figures 4, 8, 11 and col.13, line 20 – col.16, line 55). The communications protocols are interpreted to include a mixture of multicast and pointcast communications protocols. It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed and also in placing bids and completing the bid transactions.

Regarding claim 19, Wolf/Patterson/Bennett discloses that the claim 1 includes retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data and in which the sensing device contains an identification means which imparts a unique identity to the to the sensing device and identifies it as being associated with a particular auction buyer and in which the method includes monitoring, in the computer system), said identity (inherent in the disclosure of Wolff).

Regarding claims 22-28, and 30-31, their limitations are closely parallel to the limitations of claims 1-3, 5, 8, 11, 13, 19, and 15 respectively and are therefore analyzed and rejected on the same basis.

Regarding claim 29, Wolf/Patterson/Bennett as applied to claim 22 teaches that the sensing device includes a marking nib (see at least Wolff, col.7, lines 6-14, " *providing a writing point that deposits ink[or other writing medium] on to paper surface by contact.....* ").

2.2. Claims 16-17, 21, 32-35 are rejected under 35 U.S.C. 103(a) as being obvious over Wolff/Patterson/Bennett and further in view of Official Notice.

Regarding claims 16-17 and 21, Wolff in view of Patterson discloses a method of claim 15 which includes printing the form on demand and printing the form on a surface of a surface-defining means (inherent in the disclosure of Wolff). Wolff in view of Patterson combined do not explicitly disclose printing the coded data on a surface which is substantially

invisible in the visible spectrum and printing of multiple pages and in which the method includes binding the pages.

Official notice is taken that printing the coded data on a surface, which is substantially invisible in the visible spectrum and printing of multiple pages and in which the method includes binding the pages is old and well-known in the art. Printing coded data on a surface, which is substantially invisible in the visible spectrum enhances the security of the codes being printed and printing on multiple pages and binding them helps keep the records together. It would have been obvious to one of an ordinary skill in the art at the time of invention to include the step of printing the coded data on a surface, which is substantially invisible in the visible spectrum to the disclosure of Wolff in view of Patterson as applied to claim 1. The combination of the disclosures taken as a whole suggests that users would have benefited from the enhancement of security of the codes which are printed and keeping the records together by printing on multiple pages and binding them.

Regarding claims 32-33 and 35, their limitations are closely parallel to the limitations of claims 16-17 and 21 and are therefore analyzed and rejected on the same basis.

Regarding claim 34, Wolff in view of Patterson as applied to claim 33 further discloses retaining a retrievable record of each form generated, each form being retrievable by using its identity as included in its coded data (Inherent in disclosure of Wolff).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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(i) US Patent 6,603,464 B1 to Rabin (, see at least, Abstract and col.1, line 60-col.6, line 39), US Patent 6,529,189 to Fujieda et al., (see at least abstract and col.2, lines 21-59), and US Patent 5,852,434 to Sekendur (see at least Abstract) disclose methods for inputting data via a device, such as stylus or pen type to a computer on the basis of absolute positions/coordinates relative to a form.

(ii) US Patent 6,396,481 B1 to Challa et al. (see at least Abstract), US Patent 6,005,200 to Stanchak et al. (see at least Abstract) and US Patent 6,622,276 to Nagasaki et al. (see at least Abstract) disclose a method of inputting data on a printed paper form and storing the same in a computer medium.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

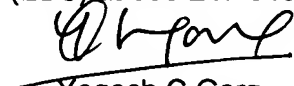
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
January 19, 2005